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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/809,699      | 03/27/97    | RIECHERS             | H 45281             |

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12M1/0910

EXAMINER

KIFLE, B

ART UNIT PAPER NUMBER

1202

3

DATE MAILED: 09/10/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/809,699

Applicant(s)

Riechers et al.

Examiner

Bruck Kifle

Group Art Unit

1202

☒ Responsive to communication(s) filed on Mar 27, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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*Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, drawn to compounds of formula I, when X is nitrogen.

Group II, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> does not form an additional ring with CR<sup>3</sup>.

Group III, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> along with CR<sup>3</sup> forms a 5-membered alkylene or alkenylene ring.

Group IV, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> along with CR<sup>3</sup> forms a 6-membered alkylene or alkenylene ring.

Group V, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> along with CR<sup>3</sup> forms a 5-membered alkylene or alkenylene ring where a methylene group is replaced by oxygen or sulfur.

Group VI, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> along with CR<sup>3</sup> forms a 6-membered alkylene or alkenylene ring where a methylene group is replaced by oxygen or sulfur.

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Group VII, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> along with CR<sup>3</sup> forms a 5-membered alkylene or alkenylene ring where a methylene group is replaced by nitrogen.

Group VIII, drawn to compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> along with CR<sup>3</sup> forms a 6-membered alkylene or alkenylene ring where a methylene group is replaced by nitrogen.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The claim lacks unity of invention because compounds of formula I do not possess single structural element that is shared by all of the alternatives. The common structural feature shared by all of the alternatives of formula I, namely the C(R<sup>2</sup>)-N=C(Y)-N=C(R<sup>3</sup>) moiety, is old. The common structural feature of formula I, is **not** a patentable advance over the prior art.

The claim is drawn to structurally dissimilar compounds which are classified separately, require separate literature searches and are not art recognized equivalents. They are made and used independently.

Note that compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept under PCT Rule 13.1, 37 CFR 1.475(d). The species of formula (I) are not so linked as to form a single inventive concept. The compounds embraced by formula (I) are so diverse in scope that a prior

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art anticipating one compound 35 USC 102 would not render obvious another compound of the same claim under 35 USC 103.

This application contains a claim directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Applicant is required, in response to this action, to elect a single species to which the claim shall be restricted if the generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Several telephone calls were made to Herbert Keil from August 27, 1997 to September 4, 1997 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicants' representative did not return any phone calls.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [mukund.shah@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Bruck Kifle

September 5, 1997

*Mukund J. Shah*  
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SUPERVISORY PATENT EXAMINER  
GROUP 1200